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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRENCE ANTON and BRADLEY DOUGLAS BARTELL

Appeal 2009-0587
Application 10/697,860
Technology Center 3700

Decided:[1] May 8, 2009

Before LORA M. GREEN, RICHARD M. LEBOVITZ, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 22-30, 32, 33, 35-37, and 39-48. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The claims are directed to a course for playing a golf type game.

Claims 22 and 39 are the independent claims on appeal, and read as follows:

22. A course layout for players of varying playing ability to play a game using at least one club and a limited flight tennis-like ball, the course layout comprising:

a plurality of repeated modular holes, each of the plurality of repeated modular holes contained within a rectangular boundary of substantially equal dimensions and comprising:

a substantially rectangular playing area located proximate a first end of the rectangular boundary;

a plurality of teeing areas located at different positions within the rectangular boundary, the positions of the plurality of teeing areas are unassociated with the varying playing ability of the players, at least one of the plurality of teeing areas located proximate a second end of the rectangular boundary and at least one of the plurality of teeing areas located proximate a first side of the rectangular boundary;

a fairway positioned between the second end and the substantially rectangular playing area whereby at least a portion of the fairway is positioned between a first teeing area and the substantially rectangular playing area and between a second teeing area and the substantially rectangular playing area;

a standardized set of irrigation pipes extending along a length of the rectangular boundary; and

wherein the substantially rectangular playing area comprising a putting green, a mounded area adjacent a first side of the putting green and a chipping area proximate a front portion of the putting green.

39. A course for playing a golf type game using at least one club and a ball, the course comprising:

a plurality of repeated modular holes of substantially equal rectangular dimensions, each of the plurality of repeated modular holes comprising a fairway having substantially the same length;

a putting green located proximate a first end of each of the modular holes;

a plurality of teeing areas within the rectangular dimension of each of the modular holes and positioned with respect to the putting green of the modular hole to define a respective plurality of course-playing routes of varying distances from respective ones of the plurality of teeing areas to the putting green, the positions of the plurality of teeing areas being unassociated with the varying playing ability of the players, at least one of the plurality of teeing areas positioned proximate a second end of the modular holes; and

a playing area surrounding each putting green and comprising at least one of a mounded area and a chipping area.

The Examiner relies on the following evidence:

Beam	US 4,225,136	Sep. 30, 1980
Aberg	US 4,413,827	Nov. 8, 1983
Taniguchi	US 5,076,586	Dec. 31, 1991
Shaw	US 5,451,000	Sep. 19, 1995
Armstrong, III	US 6,217,458 B1	Apr. 17, 2001
Jones	WO 95/02436	Jan. 26, 1995

The following grounds of rejection are before us for review:

I. Claims 39, 40, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam;

II. Claims 22-28, 30, 32, 33, and 34 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam as further combined with Shaw;

III. Claims 29 and 45 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Jones, Beam, and Shaw, as further combined with Taniguchi;

IV. Claims 35-37 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Jones, Beam, and Shaw, as further combined with Armstrong;

V. Claims 46-48 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam, as further combined with Armstrong; and

VI. Claim 41 stands rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam, as further combined with Aberg.

We affirm all the rejections on appeal.

ISSUE(S)

The Examiner concludes that the claims on appeal are rendered obvious by the combination of Jones and Beam, as further combined with Shaw, Armstrong, Taniguchi, and Aberg as needed.

Appellants contend that none of references cited by the Examiner, either individually or in combination, discloses or suggests the plurality of modular holes or plurality of teeing areas, as recited in independent claims 22 and 39, and that both Jones and Beam teach away from combining the references as suggested by the Examiner.

Thus, the issue on appeal is: Have Appellants demonstrated that the Examiner erred in combining the references to arrive at the subject matter of independent claims 22 and 39, or that either of Jones and Beam teach away from combining the references as suggested by the Examiner?

FINDINGS OF FACT

FF1 According to the Specification, the invention relates to course layouts and designs (Spec. 1).

FF2 The Specification notes that traditional 18-hole golf courses require large areas of land, typically 150-200 acres, and that such golf courses are difficult to design, construct, as well as maintain (*id.*).

FF3 The Specification thus teaches that "embodiments of the invention allow for cost effective design, construction, and maintenance of a course that minimizes land use and afford players to play a game, which may include characteristics of the traditional game of golf." (Spec. 3.)

FF4 The Examiner rejects claims 22-28, 30, 32, 33, and 44 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones, Beam, and Shaw (Ans. 3).

FF5 Appellants only present arguments as to the combination of Jones and Beam (*see, e.g.*, Appeal Br. 6-9), and we thus focus on the teachings of those two references.

FF6 The Examiner finds that Jones teaches "the claimed course with the exception [of] the use of substantially equal rectangular dimensions for each hole." (Ans. 4.)

FF7 As to tee positions, the Examiner finds further that "Jones discloses that it is known to locate tees at various positions along the fairway," and that "[h]ow the tee areas are used is not at issue." (*Id.*)

FF8 The Examiner also finds that Jones discloses holes that "share a common water hazard though they do not overlap with any part of the terrain of each other." (*Id.* at 6 (citing holes 6, 7, and 9 Figure 2A of Jones).)

FF9 Jones "relates to golf courses, and more particularly to a scheme for substantially equalizing the degrees of difficulty encountered by players of different skills and abilities in playing any hole on the course, and a scheme for reducing the land area required for a traditional golf facility including a golf course and a driving range." (Jones, 1, ll. 7-10.)

FF10 Specifically, Jones teaches a 9 or 18-hole golf course that includes "an initial teeing area and a plurality of supplemental teeing areas, a target green, a middle area comprising the area between the initial teeing area and the target green, and a border green comprising the area beside and behind the target green in relation to the teeing area." (*Id.* at 3, ll. 4-7.) "The middle area and border green comprise variable terrain of various surfaces, including cut and uncut grass, various contours including flat surfaces, gullies and mounds, and various obstacles, including trees, water hazards, boulders and sand traps." (*Id.* at 3, ll. 10-13.)

FF11 Figure 2A of Jones is reproduced below.

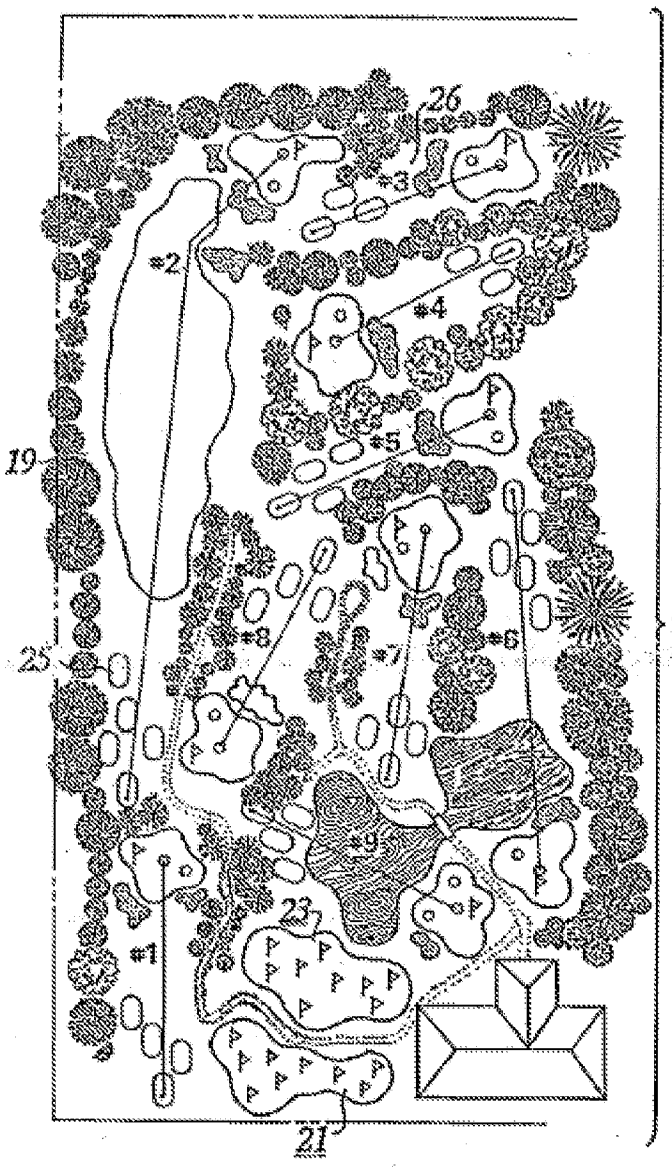

Figure 2A

Figure 2A is part of "a layout of a golf facility including a plurality of holes for a golf course." (*Id.* at 4, ll. 27-28.)

FF12 As shown in Figure 2A, different holes of the course can comprise different numbers of teeing areas (*id.* at 7, ll. 24-27).

FF13 The teeing areas are arranged "so that two players with different abilities to drive a golf ball for distance and to drive a golf ball with accuracy can tee off from different particular teeing areas and encounter levels of difficulty with respect to the skill levels involved." (*Id.* at 3, ll. 20-23.)

FF14 Jones teaches that holes 1 through 9 "are arranged as in a typical with the green of one hole lying adjacent to the initial teeing area of the hole bearing the next higher number, with no hole overlapping any part of the terrain associated with any other hole." (*Id.* at 7, ll. 21-24.)

FF15 Jones also shows another preferred embodiment in Figure 3 (not shown here), wherein no hole overlaps any part of the terrain associated with any other hole (*id.* at 8, ll. 17-18).

FF16 The Examiner finds that Beam teaches that it is known to the ordinary artisan to use substantially equal rectangular dimensions for each hole (Ans. 4).

FF17 Beam "relates generally to a golfing structure, and more particularly concerns such a structure which is divided into relatively narrow portions which in turn include conventional or simulated putting green surface regions, hazard surface regions and fairway surface regions, so that each portion presents a particular approach shot to the player." (Beam, col. 1, ll. 7-13.)

FF18 Beam notes that the building of conventional golf courses has declined due to expense, especially near metropolitan areas where the land required may not be available or too expensive to use for a golf course (*id.* at col. 1, ll. 30-36).

FF19 Figure 1 of Beam is reproduced below:

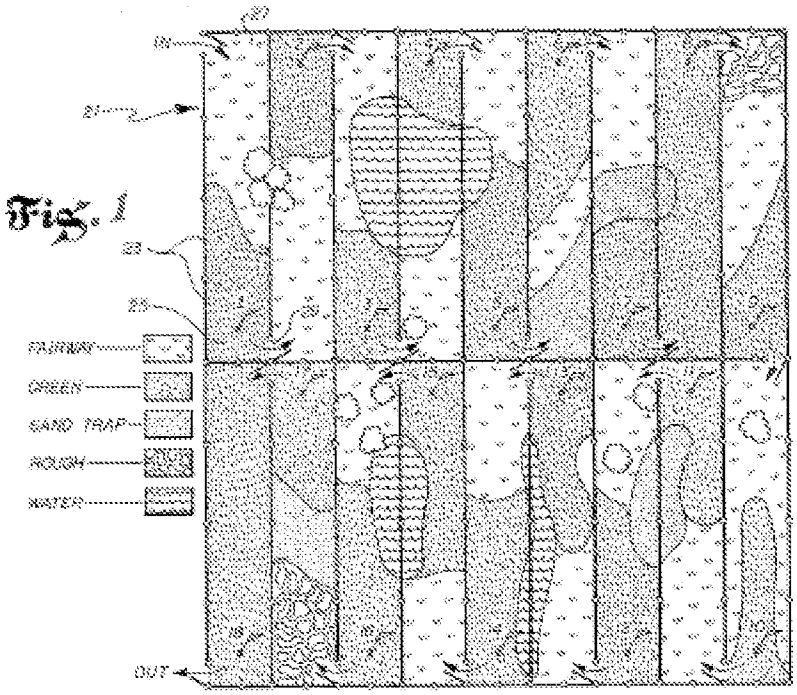

Figure 1 is a plan view embodying the course disclosed by Beam (*id.* at col. 2, ll. 35-36).

FF20 Beam teaches that the grid structure of Figure 1 "is extremely compact, and requires relatively little ground area compared to a full-size golf course." (*Id.* at col. 4, ll. 29-32.)

FF21 As can be seen in Figure 1, the golf structure of Beam is generally square in outline, and is divided into 18 holes (*id.* at col. 2, ll. 51-62).

FF22 According to Beam, the "portions of the present structure are each arranged to present a particular shot to the player which he may encounter in the approach area of a hole in a full-size course." (*Id.* at col. 3, ll. 35-38.)

FF23 Each of the portions include a putting green surface, and may "include a combination of additional surface areas, such as fairway, sand, rough and

water, as well as obstacles such as shrubs and trees." (*Id.* at col. 3, ll. 63-66.)

FF24 Beam teaches that in order to accommodate players of different skill levels, there may be "starting points of varying difficulty in a given portion." (*id.* at col. 4, ll. 46-49.)

FF25 Beam teaches that "[e]ach portion will include boundary walls which substantially surround the perimeter of each portion, to prevent golf balls from escaping from each portion," wherein the "wall may be a fence, or natural protection such as shrubs or trees." (*Id.* at col. 5, ll. 13-18.)

FF26 The Examiner concludes "[i]t would have been obvious to one of ordinary skill in the art to have provided Jones' holes in the same manner if it was desired to provide a more compact golf course." (Ans. 4.)

FF27 The Examiner also rejects claims 39, 40, 42, and 43 as being obvious over the combination of Jones and Beam (Ans. 3).

FF28 The Examiner rejects claims 29 and 45 as being obvious over the combination of Jones, Beam, and Shaw, as further combined with Taniguchi (*id.* at 4).

FF29 The Examiner rejects claims 35-37 as being obvious over the combination of Jones, Beam, and Shaw, as further combined with Armstrong (*id.*).

FF30 The Examiner also rejects claims 46-48 as being obvious over the combination of Jones and Beam, as further combined with Armstrong (*id.* at 5).

FF31 Finally, the Examiner rejects claim 41 as being obvious over the combination of Jones and Beam, as further combined with Aberg (*id.*).

PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

> If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. It is proper to "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. *See also id.* at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

Moreover, "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated technical success, it is likely the product not of innovation but of ordinary skill and common sense." *KSR*, 550 U.S. at 421.

"Under the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of applicant's invention. A statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination." *Syntex (USA) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed. Cir. 2005) (citations deleted).

ANALYSIS

As to the rejection of claim 22 over the combination of Jones, Beam, and Shaw, Appellants argue that none "of the Jones, Beam or Shaw references, either individually or in combination, . . . discloses the plurality of repeated modular holes or plurality of teeing areas, as recited in independent claim 22." (App. Br. 6.)

Jones, Appellants assert, "discloses a conventional golf course with different length holes," but "emphasizes that the golf course is conditioned upon 'no hole overlapping with <u>any part of the terrain</u> associated with any other hole.'" (*Id.* (quoting Jones, 7, ll. 23-24; *also* citing Jones, Fig. 2A, Jones 8, ll. 17-18).) Beam, Appellants contend, "discloses a golf structure with eighteen 'portions' 1-18, where 'the combination of surface regions, obstacles and <u>terrain</u> of each 'portion' is designed to duplicate a particular shot condition found within an approach area in a conventional golf hole.'" (App. Br. 6 (quoting Beam, col. 4, ll. 60-63).) According to Appellant:

> As illustrated in FIG. 1 of Beam, several "portions" overlap with the terrain of other "portions," such as "portions" 3-5, 15-16, and 13-14 having mutually overlapping water terrain, and "portions" 7-8 and 11-12 having mutually overlapping sand terrain, for example (See FIG. 1 legend designating shades of

> terrain). Additionally, Beam advocates utilizing hedges and tree terrain along the common boundaries of adjacent "portions" (Col. 3, line 10; see portions 1-2 in FIG. 1), thereby introducing additional terrain overlap among adjacent "portions" 1 - 18.

(App. Br. 7.)

Appellants argue that Jones and Beam teach away from the combination, as "the teachings of Jones emphasizes, on two occasions, that the golf course must not include any hole which overlaps with any part of the terrain of another hole." (*Id.*) Beam, Appellants assert, is the "antithesis of overlapping the terrain of adjacent portions/holes, as it teaches freely sharing water terrain, freely sharing sand terrain, and distributing tree/hedges among adjacent portions/holes." (*Id.*) Appellants thus argue that the Examiner has engaged in impermissible hindsight, using the instant disclosure as a roadmap, to arrive at the subject matter of claim 22 (*id.*).

Moreover, Appellants argue that Beam teaches away from the combination, as Beam "discourage[s] the construction of a traditional sized-golf-course, such as in Jones," as Beam teaches that "'in recent times, the building of conventional golf courses has declined due to rising costs, until today, relatively few full-sized courses are being built, particularly in or near metropolitan areas, as the land required is either no longer available in those areas or is too expensive for use of a golf course.'" (*Id.* at 9 (quoting Beam, col. 1, ll. 30-36).)

Appellants argue further that the Examiner's contention that it would have been obvious to modify Jones to provide a more compact course is in error, as "the teachings of Jones discussing the reduction of space for a golf

facility were limited to the driving range." (App. Br. 8.) Appellants argue further that even if the ordinary artisan were to down-size the regular-sized holes of Jones, one would have to necessarily remove the multiple teeing areas of Jones, defeating the purpose of Jones (*id.*).

Appellants' arguments have been carefully considered, but are not found be convincing. While Jones does state that no hole has terrain that overlaps terrain associated with any other hole (FF14, FF15), the ordinary artisan would understand that to mean that holes do not cross, or share a fairway, etc., such that it would be confusing as to who is playing what ball and to prevent players from being hit from balls of players playing another hole.

That finding is supported by Figure 2A of Jones (FF11). As can be seen in that figure, holes 6 and 9 share a water hazard (*see, e.g.*, FF8). In addition, there is a stand of trees shared between holes 2 and 8, and holes 6 and 7. Moreover, Beam also recognizes the need to have no overlapping fairway. Specifically, Beam teaches that "[e]ach portion will include boundary walls which substantially surround the perimeter of each portion, to prevent golf balls from escaping from each portion," wherein the "wall may be a fence, or natural protection such as shrubs or trees." (FF25.)

As to Appellants' argument that Beam teaches away from the combination by discouraging the construction of traditional sized golf courses, such as that taught by Jones, the ordinary artisan would understand that the course would have to be constructed to fit into the available space, and it is well known in the art to build different size courses. Finally, Appellants' argument that if one were to down size the regular sized holes of

Beam, one would have to "necessarily remove the multiple teeing areas of Jones, thereby defeating the entire purpose of Jones" (App. Br. 8), is also not convincing, as Beam teaches that in order to accommodate players of different skill levels, there may be starting points of varying difficulty in a given portion (FF24). Moreover, we also agree with the finding of the Examiner that Jones discloses that it is known to locate tees at various positions along the hole (FF7).

As to the rejection of independent claim 39 over the combination of Jones and Beam, Appellants reiterate the arguments made with respect to claim 22 (App. Br. 9-10). Those arguments are not found to be convincing for the reasons set forth with respect to claim 22.

Finally, as Appellants do not present separate arguments as to the remaining rejections, the claims rejected by those rejection fall with independent claims 22 and 39.

CONCLUSION(S) OF LAW

We conclude that Appellants have not demonstrated the Examiner erred in combining the references to arrive at the subject matter of independent claims 22 and 39, or that either of Jones and Beam teach away from combining the references as suggested by the Examiner.

In addition, Appellants present no other arguments with respect to the remaining rejection. Thus, we affirm those rejections for the reasons set forth with respect to independent claim 22.

Thus, we affirm:

I. The rejection of claims 39, 40, 42, and 43 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam;

II. The rejection of claims 22-28, 30, 32, 33, and 44 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam as further combined with Shaw;

III. The rejection of claims 29 and 45 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones, Beam, and Shaw, as further combined with Taniguchi;

IV. The rejection of claims 35-37 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones, Beam, and Shaw, as further combined with Armstrong;

V. The rejection of claims 46-48 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam, as further combined with Armstrong; and

VI. The rejection of claim 41 under 35 U.S.C. § 103(a) as being obvious over the combination of Jones and Beam, as further combined with Aberg.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Ssc:

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